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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/035,763

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L. Jeffrey Kapner III

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EXAMINER

NEWLIN, TIMOTHY R

ART UNIT

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2424

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/035,763

Applicant(s)

KAPNER ET AL.

Examiner

Timothy R. Newlin

Art Unit

2424

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2008.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-10 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1 and 3-10 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

Applicant's arguments have been fully considered but they are not persuasive. Applicant argues that claim 1 is different than Emura because it resolves scheduling conflicts based on the status of one or more tuners near the time of the potential transmission, rather than when the recording is set up. However, claim 1 only recites that the timing is both predetermined and prior to the transmission of the program. Furthermore, claim 1 determines an "availability status," which can be reasonably read to pertain to whether the path will be available for the potential recording. Emura meets this by determining, at a time prior to a transmission, whether the delivery path (in this case a single tuner) will be available at the potential transmission time, based on whether a simultaneous recording has previously been set up. Overall, the language of claim 1 (in particular limitations f, g, and h) is not sufficiently clear to distinguish over Emura.

Applicant also makes a distinction between resolving conflicts relative to the availability of a content path (i.e. tuner status), and relative to a program schedule. However, Emura is actually basing its conflict determination on the fact that only one tuner at a time is available to tune and record. Emura finds a conflict when a program recording is set up for a time when the tuner will be unavailable because it will already be recording. Thus the determination is inherently based on tuner status. The two programs may be transmitted by the headend simultaneously, according to the

schedule; it is the fact that the tuner will be occupied that results in a conflict, not the schedule itself. Moreover, claim 1 is not limited to a multiple tuner system, as described in the Applicant's example. While Emura only address a situation where one tuner is used, it nevertheless determines whether that single path (tuner) will be available.

With respect to claims 3 and 4, the distinction argued with respect to Emura is addressed above. Applicant also states that Ellis provides no reason to select a different transmission time if a user does not allow the channel change. However, neither claim 3 or 4 appears to require the selection of a different transmission time as argued. The combination of Emura, which teaches the tuner availability determination, and Ellis, which teaches the channel change request, is believed to meet all limitations of claims 3 and 4 and therefore those rejections stand.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 5, and 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schlarb (US 2004/0078823) in view of Mendelsohn (US 6,771,886), and further in view of Emura (US 6,344,878).

As regards Claim 1, Schlarb discloses a method of selecting a pay per view program to be transmitted to a program receiver, the method comprising:

a) obtaining a schedule of pay per view programs each programs having a title and a plurality of transmission times **[fig. 3.302]**;

b) generating a menu (such as an EPG) comprising the titles of at least one pay per view program, based on the schedule **[Fig. 3]**;

c) providing the menu to a display device for display to the user **[paragraph 17, lines 6-9]**; and

d) receiving from the user a selection by title of the pay per view program from the menu to be received by the program receiver **[paragraph 20, lines 6-7]**.

Schlarb fails to disclose e) determining a potential transmission time of the pay per view program to be received by the program receiver based on the plurality of transmission time in the schedule of pay per view programs. Mendelsohn discloses determining a potential transmission time of the program to be received by the program receiver based on the at least one transmission time in the schedule of programs **[col. 4, 18-54]**.

At the time of invention, it would have been obvious to a person of ordinary skill in the art to provide the scheduling system of Mendelsohn, an analogous art, to the PPV system of Schlarb to allow the viewer more flexibility in watching PPV events.

Schlarb and Mendelsohn fail to disclose steps f, g, and h. Emura teaches

f) determining if an availability status of a content delivery path is available at a predetermined time prior to the potential transmission time **[reservation overlap**

judging and controlling unit determines whether the content path (i.e. channel) for a desired program will be available or overlaps with a previously scheduled transmission, col. 15, 17-25];

g) if the availability status of the content delivery path is available at the predetermined time prior to the potential transmission time, requesting transmission of a program at the potential transmission time on the associated transmission channel **[program is transmitted and recorded when the content delivery path is available (i.e. there is no previously scheduled recording), col. 15, 25-32. Further, the user in Emura has “requested” the transmission of all future rebroadcasts, including the one scheduled to be recorded, by virtue of subscribing with a program provider [see Background, col. 1]; and**

h) if the availability status of the content delivery path is not available at the predetermined time prior to the potential transmission time, repeating (e) – (g) until the availability status of the content delivery path is available **[the program retrieving unit receives a program on the condition that it does not overlap with another requested program, i.e. on the condition that the content path will be available. It will not receive a program until the condition is met, cols. 15-16, line 60-27].**

While Emura does not deal specifically with a pay-per-view arrangement, it does describe an embodiment wherein replays of programs (“rebroadcasts”) are available. This is analogous to Schlarb, which does teach a pay-per-view system. Significantly, Emura addresses the problem of channel availability in a manner that applies to any

system of receiving programming that includes rebroadcasts, regardless of whether they are pay-per-view or included in a subscription.

At the time of the invention, it would have been obvious to one skilled in the art to modify Schlarb and Mendelsohn with the scheduling conflict resolution method of Emura, in order to resolve scheduling conflicts when only one television tuner is available [**See Emura, col. 5, 61-64**]. Mendelsohn also resolves scheduling conflicts, in particular between a user's schedule and the programming schedule [**cols. 3-4, lines 53-8; col. 4, 44-65**], which further suggests the desirability of preventing transmission and recording conflicts between programs.

As regards Claim 5, Emura teaches receiving a program at the potential transmission time [**col. 25, 23-33**].

As regards Claim 7, Emura further discloses j) storing a program [**col. 15, 5-9**]; and k) making the program available for viewing [**col. 25, 34-37**].

Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schlarb, Mendelsohn, and Emura as cited above, and further in view of Haddad (US 6,072,982).

As regards Claim 8, Haddad further discloses wherein the pay per view program is stored on a hard disk drive **[cols. 6 and 7, lines 67 and 1-7]**.

At the time of the invention it would have been obvious to one skilled in the art to combine the hard disk drive of Haddad with PPV recording system of Schlarb because hard disk drives are a reliable and increasingly inexpensive way of storing video content.

As regards Claim 9, Haddad further discloses that (k) further comprises displaying a notification that the pay per view program is available for display **[col. 9, lines 28-32]**.

At the time of the invention it would have been obvious to one skilled in the art to combine the notification of Haddad with PPV recording system of Schlarb and Mendelsohn so that the user knows when the program is available.

Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schlarb, Mendelsohn, and Emura as cited above, further in view of Ellis (US 2005/0235323).

As regards Claim 3, Schlarb, Mendelsohn, and Emura jointly disclose the method of Claim 1. Emura further discloses

i) determining if a program is scheduled to be recorded during the potential transmission time **[col. 15, 17-25];**

ii) if a program is scheduled to be recorded during the potential transmission time (i.e. other program segments on order), determining that the availability status of the content delivery path is not available **[reservation is changed if channel is not available during potential transmission time, i.e. there is a scheduling overlap; if there is no overlap and the channel will be available, the reservation is stored, col. 15, 25-41].**

While Emura does teach determining whether any programs are scheduled to be recorded during a potential transmission time as cited above, neither Schlarb, Mendelsohn, nor Emura disclose a channel change request protocol in the event of availability. Ellis discloses

(1) displaying a change channel request **[presented as a viewer option in fig. 4b]** to change to the associated transmission channel for the potential transmission time;

(2) waiting a predetermined wait for response time for a response to the change channel request from the user, and (5) if the response to the change channel request is not received from the user within the predetermined wait for response time for receiving the change channel request, determining that the availability status of the content path is available **[recording process involves changing to the appropriate channel, fig. 3b between blocks 312 and 314, and figs. 3b and 4a and paragraph 52].**

With respect to steps 3 and 4, if the receiver is not tuned to the correct channel (the channel on which the scheduled program is being broadcast), then the recorder is unable to record the scheduled program and the availability status of the content delivery path (channel) is not available. Likewise, if the receiver is tuned to the appropriate channel on which the scheduled program is being broadcast, then it is true that the status of the content delivery path is available.

At the time of invention, it would have been obvious to a person of ordinary skill in the art to provide the reminder system of Ellis, an analogous art, to the PPV system of Schlarb, Mendelsohn, and Emura to insure that the recording is not missed.

As regards Claim 4, Emura discloses that there are a plurality of content delivery paths (channels) each content delivery path having an associated availability status [e.g. Fig 11B], and wherein (f) is repeated until it is determined that a respective content delivery path has an availability status of available or that all content delivery paths have an associated availability status of not available **[system continually checks for scheduling overruns and resolves conflicts, cols. 19-20, lines 42-30]**.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schlarb, Mendelsohn, and Emura as cited above, and further in view of Yoshinobu (US 5,699,104). Schlarb, Mendelsohn, and Emura jointly disclose the method of Claim 5, but they do not disclose displaying a screen overlay to prevent viewing of the pay per view program during receipt of the pay per view program. Yoshinobu discloses

displaying a screen overlay to prevent viewing of the pay per view program during receipt of the pay per view program [cols. 10 and 11, lines 48-59 and 8-20].

At the time of invention, it would have been obvious to a person of ordinary skill in the art to provide the overlay system of Yoshinobu, an analogous art, to the PPV system of Schlarb, Mendelsohn, and Haddad to insure that no unauthorized viewing occurs.

Conclusion

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy R. Newlin whose telephone number is (571) 270-3015. The examiner can normally be reached on M-F, 8-5 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Chris Kelley/
Supervisory Patent Examiner, Art
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TRN